

Application No.: 10/604,302
Amendment dated: January 18, 2006
Reply to Office Action of October 18 2005
Attorney Docket No.: 21295.55

b.) Remarks

Claims 1-17 are pending in this application. Claims 1-17 are rejected. Claims 1, 11, 12 and 17 have been amended to rearrange and point out the claim elements in a clearer fashion. No new elements have been introduced to the pending Claims.

Turning now to the merits, Claims 1-17 were rejected under 35 U.S.C. 103(a) over Engelhardt (U.S. Patent 6,355,919) and further in view of Brody *et al.* (U. S. Patent 3,645,627). This rejection is respectfully traversed for the following reasons.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.² As argued below, this burden has not been met.

In its "Response to the Arguments" section of the Office Action the Patent Office stated that Engelhardt "discloses calibrating all elements (which includes the sensor) of the system, and particularly discloses in Col. 2, line 67 – Col. 3, line 2 the step of calibrating the detector...". Col. 2, line 67 – Col. 3 reads as follows:

It is possible within the scope of a further embodiment of the reference structures for the latter to be constructed to be active, for example as luminous means which serve the purpose of calibrating the detectors.

There is nothing else that could be found in Engelhardt that would say anything about the steps of calibrating a sensor as claimed in independent Claim 1 and independent Claim 11. In particular, Engelhardt has no disclosure of obtaining a first response by

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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enumerated steps, acquiring the response characteristics at later points in times, and calibrating the sensor by comparing the response characteristics to the first response characteristic to identify changes in the sensor and correct the response characteristic as claimed in Claim 1. Engelhardt also has no disclosure of calibrating the sensor by, among other steps, obtaining a first response characteristic, comparing it with the present response to come up with a corrected response and then using the corrected response in image processing to measure the features, as claimed in Claim 11. Other than the three cited lines of Engelhardt above, nothing in that patent says anything about how a detector is calibrated, let alone specifying the steps of such calibration. The above-presented elements of Claim 1 and Claim 11 absent in Engelhardt are not disclosed in Brody either, so the combination of these patents does not disclose all the elements as presented in Claim 1 and Claim 11. It is respectfully requested that the Patent Office cites the exact column and line number of Engelhardt and Brody where such disclosure can be found.

Similarly, the elements of the apparatus as claimed in independent Claim 12 and independent Claim 17 could not be found in the disclosure of Engelhard and Brody. The disclosure of the calibration means for obtaining a first response characteristic and a present response characteristic of the sensor in the UV light, and evaluation unit for correcting the present response characteristic of the sensor by using the first response and comparing it to the present response, as presented in independent Claim 12, could not be found in either of the patents or a combination of them. Similarly, the calibration means and evaluation unit specifically as claimed in independent Claim 17 could not be found in the teachings of Engelhardt or Brody. It is respectfully requested that the Patent Office cites the exact column and line number of Engelhardt and Brody where such disclosure can be found.

Moreover, with regard to some suggestion or motivation to modify the cited patents or to combine their teachings, as well as to provide a reasonable expectation of success, it has been well articulated that a factual inquiry whether to combine references

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must be based on objective evidence of record³ and that teachings of references can be combined only if there is some suggestion or incentive to do so⁴. The Patent Office is respectfully requested to provide column and line numbers in either Engelhardt or Brody where such motivation to combine with a reasonable expectation of success to come up with the invention as claimed in Claim 1, Claim 11, Claim 12, and Claim 17, could be found.

In view of the above-presented arguments Applicant asserts that the Patent Office has not established the prima facie case of obviousness and that the 103(a) rejection should be withdrawn. Allowance of independent Claim 1 with its dependent Claims 2-10, and independent Claim 11 is hereby respectfully requested. Allowance of independent Claim 12 with its dependent Claims 13-16 and independent Claim 17 is hereby also respectfully requested.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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³ *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

⁴ *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).